

## **REMARKS**

By the present amendment, claims 1 to 3 and 6 are pending in the application.

### **Restriction Requirement**

In response to the restriction requirement, applicants hereby affirm the telephone election of the claims of Group I, i.e., claims 1 to 6, for further prosecution in the application.

By the present amendment, non-elected, withdrawn claims 7 to 17 have been canceled without prejudice to the filing of a divisional patent application directed to the subject matter of non-elected, withdrawn claims 7 to 17.

### **Claim Amendments**

#### **Claim 1**

The limitation  $0.3 \leq [H]$  is supported in the specification, e.g., at page 11, line 1.

The limitation directed to  $T_f$  is supported by original, now canceled, dependent claim 4. The limitation  $0.5 \mu\text{m} \leq T_f \leq 2 \mu\text{m}$  is supported in the specification, e.g., at page 12, lines 25 to 26.

The limitation directed to  $T_f \leq T_s/40$  is supported by original, now canceled, dependent claim 5 and the specification, e.g., at page 13, lines 10 to 11.

### **§103**

Claims 1, 2 and 4, 5 were rejected under 35 U.S.C. §103(a) as being unpatentable over Japan No. 2000-349312 to Tezuka et al. in view of U.S. Patent No. 5,595,826 to Gray et al.

Claims 3 and 6 were rejected under 35 U.S.C. §103(a) as being unpatentable over Japan No. 2000-349312 to Tezuka et al. in view of U.S. Patent No. 5,595,826 to Gray et al. and further in view of Japan No. 11-269657 to Kamiya et al.

These rejections, as applied to the amended claims, are respectfully traversed.

### **Patentability**

As stated in amended claim 1, in the inorganic-organic hybrid film-coated stainless steel foil of the present invention, the thickness  $T_f$  of said inorganic-organic hybrid film and the thickness  $T_s$  of said stainless steel satisfies the condition of  $T_f \leq T_s/40$ . If  $T_f > T_s/40$ , the macroscopic flatness of the stainless steel foil is impaired, since the stainless foil cannot withstand the stress generated when the film shrinks during the film formation and, as a result, deformation occurs (see page 13, lines 1 to 11 of the specification).

However, Tezuka et al. does not disclose or suggest the feature " $T_f \leq T_s/40$ " and its effect. In the Example of Tezuka et al., the thickness of the polysiloxane layer is 2  $\mu\text{m}$ , but the thickness of the stainless steel substrate is 50  $\mu\text{m}$ , by which  $T_f = T_s/25 > T_s/40$ .

Further, Tezuka et al. does not disclose or suggest the condition of  $0.3 \leq [H] / [Si] \leq 10$  and does not specify that the thickness  $T_f$  of said inorganic-organic hybrid film satisfies the condition of  $0.5 \mu\text{m} \leq T_f \leq 2 \mu\text{m}$ . When  $0.3 \leq [H] / [Si] \leq 10$ , cracking resistance, high hardness, heat resistance, adhesion and insulating property are obtained by virtue of flexibility even for a substance requiring high-grade processability, such as stainless steel foil (specification, page 10, line 25 to page 11, line 1). When the thickness  $T_f$  satisfies the condition of  $0.5 \mu\text{m} \leq T_f \leq 2 \mu\text{m}$ , the inorganic-organic hybrid coat can be uniformly coated on the stainless steel foil substrate (page 12, lines 13 to 26).

The present invention must satisfy, in combination, all the above requirements to obtain the desired effects, excellent heat resistance, processability, flatness,

insulating property and the like, but Tezuka et al. does not disclose or suggest these combined requirements and their effects.

Therefore, the present invention is patentable over Tezuka et al.

Gray et al. teaches curable organopolysilaxane compositions with improved adhesion (Title), and the concentration of the organohydrogenpolysilaxane component is from 0.5 to 10 silicon-bonded hydrogen atoms, for each silicon-bonded alkenyl radical in component (A) (col. 3, lines 29-32).

In Gray et al. the silicon-bonded alkenyl radical of the organohydrogenpolysilaxane component reacts with the silicon-bonded hydrogen atoms by an addition reaction, and the product by the addition reaction is cross linking between the two types of organopolysilaxane components through the hydrogen-added alkenyl radical.

The thus obtained product of Gray et al. is different from an inorganic three-dimensional network structure mainly comprising a siloxane bond, with at least one cross linked oxygen of said skeleton being replaced by an organic group and/or a hydrogen atom. In the present invention, an organic group and/or a hydrogen atom cross linked with the siloxane bond is a free terminal group or atom, but the hydrogen and the alkenyl group of the organopolysilaxane components form a cross linking between the organopolysilaxane components, or the reacted hydrogen and alkenyl group are not terminal groups any longer after the reaction.

Therefore, Gray et al. is essentially different from the present invention.

Furthermore, there is no reason one skilled in the art would combine Tezuka et al. with Gray et al.

Claims 3 and 6 depend from independent claim 1. Kamiya et al. discloses or suggests nothing with respect to independent claim 1. Furthermore, there is no suggestion in Kamiya to modify Tezuka's film.

It is therefore submitted that amended independent claim 1, and claims 2, 3 and 6 dependent thereon, are patentable over Tezuka et al. in view of Gray et al. and further in view of Kamiya et al.

### CONCLUSION

It is submitted that in view of the present amendment and foregoing remarks, the application is now in condition for allowance. It is therefore respectfully requested that the application, as amended, be allowed and passed to issue.

Respectfully submitted,

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